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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,533	11/08/2001	James Clough	10015195-1	2570

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EXAMINER	
RUHL, DENNIS WILLIAM	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,533	CLOUGH ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1,3-8,10-12,18-21, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, claims 1,3-8,10-12,18-21 only recite an abstract idea. The recited steps of locating an appropriate lodging facility (or simply a facility) that satisfies certain user defined criteria does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all (the claim does not require any technology). The recited steps could be done by two people interacting verbally and looking up lodging facilities from a book, which involves no technology.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14,26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 14, the examiner considers this claim indefinite because it is not clear what is being claimed. Applicant has claimed that a system determines the lodging facility requirements but to the examiner it seems that the facility requirements are entered by the user of the system, so it is not known what it means to be "compatible" with "hardware" "associated" with a system as claimed. What is meant by "associated"? Associated in what manner? The computer service is to be compatible with hardware that is "associated" with a system? How could one wishing to avoid infringement know what the scope of this claim is? Isn't the computer related service supposed to be compatible with the system the user owns?

For claim 26, it is not known what it means to be compatible with a device (any device in the world?) that is used to generate a request to locate a facility. How can a computer service be considered compatible with a pencil (which is a device that can be used to generate a request for lodging)? What kind of devices are in the scope of this claim and what kinds are not?

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 22,24-26, are rejected under 35 U.S.C. 102(b) as being anticipated by Schneider et al. (5832452).

For claim 22, Schneider discloses a system for assisting a user in locating a lodging facility that satisfies certain user-defined criteria. The system has a storage device 13 that stores lodging facility information and a processor 11. The storage device of Schneider is configured as claimed (is capable of storing the claimed information) and the processor operates as claimed.

For claims 24-26, these claims are reciting the type of computer related service that can be searched for. The device of Schneider is fully capable of storing the claimed type of information.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-21,23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (5832452).

For claims 1-4,9,13,14,18-20, Schneider discloses a system and method for assisting a customer in finding a lodging facility. Schneider discloses that a customer can submit a request to locate a lodging facility that will offer particular services. A computer system contains hotel information and uses customer entered criteria to perform a search for a lodging facility that satisfies the entered criteria, and displays the resulting list. See column 2, lines 55-58; column 3, lines 46-48; column 3, line 67 to column 4, line 13; column 4, lines 25-34 and column 4, lines 36-39. Schneider discloses that the criteria that the system uses to perform the search can be those disclosed in column 3, line 67 to column 4, line 2. Schneider does not specifically disclose that the customer can perform a search for facilities that offer a certain computer related service. Schneider discloses that the amenities that a particular hotel offers, such as whether or not there is a fax machine in the room, are displayed to the customer. See column 5, lines 30-35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system of Schneider allow a user to also search for the type of amenities they desire in a hotel. This would include

looking for a facility that has a fax machine in the room. Schneider recognizes various search categories that are able to be searched, and it would have been obvious to have one category be the amenities offered, such as a fax machine (a computer related service).

For claims 5,7,8,15, not disclosed is that the computer related service is a broadband connection, a printer at the front desk of the facility or in a conference room. The above 103 combination results in the user being able to search for the amenities that a hotel offers, such as if there is a fax machine in the room and the examiner considers it obvious to one of ordinary skill in the art at the time the invention was made to allow the user to search for amenities such as whether or not there is a broadband connection or a printer at the front desk. The type of amenity being searched for will not be sufficient to patentably distinguish over the prior art.

For claims 6,16, Schneider discloses what is claimed because a fax machine has a printer. A fax machine is also a printer.

For claims 10,17, Schneider discloses the printing of a reservation form so the customer can make a reservation once a satisfactory facility is located.

For claims 11,12,23, not disclosed is the generation of a report that identifies how many reservations are made by using the claimed method. This is basic analysis of how effective a marketing tool is. It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a report of some kind that shows whether or not the marketing of the hotel in the system of Schneider is worthwhile. Clearly one would want to know how effective the system of Schneider is so that one's

marketing campaign for the hotel is as successful as possible. If no reservations are ever made by the use of the system of Schneider it may not be worthwhile to continue with the use of the system.

For claim 21, not disclosed is that the facility is for an airport. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of Schneider for airports. Schneider allows one to search for a facility using search criteria, so the use of the method of Schneider for any type of facility, whether it be for restaurants or airports, or for health spas is considered obvious.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakano (2001003815), Lewin et al. (20010005831), Brondrup (20030208386), and Cochran et al. (4879648) disclose systems and method for looking up a facility based on search criteria, including hotels or lodging facilities.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER